



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Attorney Docket No. 53470.000046
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Justin LANGSETH et al.) Examiner: Elaine L. Gort
)
Serial No.: 09/488,924) Group Art Unit: 3627
)
Filed: January 21, 2000) Confirmation No. 5121

For: SYSTEM AND METHOD FOR REVENUE GENERATION IN AN AUTOMATIC,
REAL-TIME DELIVERY OF PERSONALIZED INFORMATIONAL AND
TRANSACTIONAL DATA

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is Appellant's Reply Brief (submitted in triplicate) responsive to the Examiner's Answer mailed February 9, 2005, in connection with the above-captioned patent application. Appellant presents this brief to clarify points raised by the Examiner in the Examiner's Answer.

I. The Examiner's Answer Highlights The Fundamental Flaw In The Reference Combination Proposed

In the Examiner's Answer, the Examiner repeats the Harrington and official notice combination with respect to all pending claims. Specifically, claims 1-27 are rejected on the Harrington/Official Notice combination. The Examiner asserts that "there is a reasonable expectation of success that the services provided to users of the Harrington system could be provided for users only after they subscribe so that the providers of this service can generate

revenue.” The Examiner also asserts that based on Harrington’s discussion of users registering for the services (see Col. 5, lines 52+), “it is reasonable to foresee that a user could subscribe to the services at that time.” What is fundamentally lacking in this analysis, however, is any indication in any of the art that lack of user subscription in the Harrington system is a problem that needs to be solved, or why one would be motivated to modify the Harrington system to include such a subscription feature.¹ Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”).

Here, there has been no citation of any teaching anywhere in the art of any need for the Harrington system to be modified to include user subscription. The Examiner has failed to identify any teaching of that problem for the types of systems disclosed by Harrington. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been

¹ The Answer also asserts that one skilled in the art would be motivated to modify Harrington to require user subscription to generate revenue. Appellant respectfully submits, however, that such an assertion was improperly based upon the teachings of the pending application, rather than on the teachings of the prior art. *See* Page 6, lines 6-8 (“Specifically, one embodiment provides a personalized network that actively broadcasts highly personalized and timely information via email, spreadsheet programs (over email), pager, telephone, mobile phone, fax, personal digital assistant, HTML email and other formats to generate revenues from subscription fees, transactional fees and advertising fees.”)

motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention. Because such a proper motivation to combine is missing, the entire combination is improper and the rejection should be overturned.

Applicant intends to present these and other arguments -- such as the deficiencies of the Examiner's newfound references to the Harrington patent in connection with claims 1-27 -- at oral hearing to highlight deficiencies in the proposed combinations in which the Examiner appears to be piecing together a reference and official notice to yield an invention that has no relation whatsoever to the claimed systems and methods.

II. The Examiner Has Failed To Meet The Burden Of Proof

Under U.S. law, an inventor is entitled to a patent for any invention that is new, useful, and non-obvious. 35 U.S.C. §101-103. The Answer has not presented a *prima facie* case of non-obviousness by which to deny a patent to Appellant. Rather than providing statements of motivation *as taught by the references*, the Examiner merely states that "it is reasonable to foresee that a user could subscribe" without providing sufficient reasoning as to why one of ordinary skill in the art would have been motivated to modify Harrington to permit user subscription. The Examiner summarily concludes that the claim limitations are met without sufficiently explaining why one of ordinary skill in the art would (1) combine Harrington with the purportedly well-known subscription features, and (2) how the resulting combination meets the claimed inventions.

Even if the references could be combined as suggested by the Examiner, the resulting combination would nevertheless fail to teach the combination of claim limitations recited by Appellant. For example, the Answer and final Office Action merely assert the Harrington patent and the taking of official notice that it is allegedly “well known” in the art to charge subscription fees. Thus, even if the proper motivation or suggestion to combine were properly asserted and found to exist, the ultimate combination achieved would not result in the claimed invention, but rather in a system that charges fees to search through web sites of various product and service providers and receive a list of the ones that match particular search criteria (such as a particular good or product)—a far cry from the more sophisticated “system for delivering personalized informational content to subscribers” covered by claim 1, for example.


CONCLUSION

For at least the foregoing reasons, the rejections of claims 1-27 should be reversed.

Respectfully submitted,

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